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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,977	08/30/2001	Ken Kutaragi	100809-16280 (SCEW 18.970	7679

			EXAMINER
26304	7590	10/05/2005	ELMORE, JOHN E

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ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/942,977	KUTARAGI ET AL.
	Examiner	Art Unit	
	John Elmore	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>7/25/2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1 and 3-20</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1 and 3-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>30 August 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☒ All   b)☐ Some *   c)☐ None of:

　　　1.☒ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   In response to the previous office action, Applicant has amended claims 1, 3-11,

13, 15 and 17, has cancelled claim 2, and has added claims 18-20. Claims 1 and 3-20

have been examined.

Claim Rejections - 35 USC § 101

2.   In view of Applicant's amendment, the previous rejections under 35 U.S.C. 101

are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1.   **Claims 1, 3-15 and 17-20 are rejected under 35 U.S.C. 102(b)** as being

anticipated by Ginter et al., hereafter Ginter, (US Patent Number 5,892,900).

Regarding claim 1, Ginter teaches a method executed in a computer system for

monitoring utilization condition of contents, wherein said computer system is provided

on a network on which a user terminal is allowed to connect, comprising the steps of:

equipping information gathering means on the network (VDE on client

processes contents usage metering information and connects to server on the network;

column 11, lines 36-56, and column 17, line 56, through column 18, line 5);

registering authentication information on a database (col. 160, lines 52-64;

col. 163, lines 38-66; col. 165, lines 55-64; col. 166, lines 31-34; col. 208, lines 8-16;

col. 210, line 49-col. 211, line 2; col. 212, line 1-16);

embedding digital information in said contents, said digital information

causing said user terminal to automatically transmit a contents utilizing history indicating

a utilizing condition of the contents to said information gathering means at a

predetermined timing (embedding digital information in contents via container; col. 134,

line 67-col. 135, line 1; col. 134, lines 15-28; col. 135, lines 35-58; VDE on client

monitors content usage and reports usage history to server periodically; column 18,

lines 1-6; column 18, lines 22-24; column 33, lines 36-65; column 36, lines 10-43;

column 137, lines 7-9; and column 141, lines 35-56);

distributing digital information embedded in said contents to said user

terminal, wherein said user terminal includes a memory medium in which authentication

information is included, and wherein said terminal is authenticated by said

authentication information in the memory medium (col. 17, lines 42-48, col. 18, lines 6-

21; col. 210, line 49-col. 211, line 2; col. 216, lines 54-58; col. 220, lines 1-58; col. 221,

lines 18-22; col. 233, lines 36-37; col. 234, lines 29-32);

gathering, according to the digital information included in the distributed

contents, said contents utilizing history via said information gathering means which is

automatically transmitted from the user terminal (col. 23, lines 37-44; col. 33, lines 36-65; col. 168, lines 1-15; col. 176, lines 58-65; col. 188, lines 29-38);

recording the gathered contents utilizing history, in correspondence with said registered authentication information, in the database (col. 23, lines 37-44; col. 33, lines 36-65; col. 168, lines 1-15; col. 176, lines 58-65; col. 188, lines 29-38); and

creating utilizing information indicating how much the particular content is utilized based on said contents utilizing history collected through said information gathering means (col. 35, lines 13-53; col. 55, lines 44-51; col. 150, line 44-col.151, line 36).

Regarding claim 3, Ginter teaches all the limitations of claim 1, and further teaches the step of authenticating whether said user terminal and said contents utilized in said user terminal are proper or not, based on registered history data of transaction indicating that said contents are properly transacted and also based on registered user terminal identification data for authentication (column 11, lines 58-61; column 12, lines 31-37; column 21, lines 48-59; column 28, lines 17-42; and column 35, lines 13-53).

Regarding claim 4, Ginter teaches all the limitations of claim 3, and further teaches the method wherein said authenticating step is executed on said user terminal to which said recording medium is loaded by recording said user terminal identification data to said data recording area of the recording medium and distributing said history data of transaction along with said contents (client network ID and site ID identify client terminal; column 25, lines 28-35; column 131, lines 28-61; and column 150, lines 49-52).

Regarding claim 5, Ginter teaches all the limitations of claim 1, and further

teaches that said user terminal transmits said contents utilizing history to said

information gathering means on condition that the number of times of utilizing the same

content by the same user exceeds a predetermined number (budget sets limit on

number of times user can utilize the same content; column 21, lines 48-59; column 28,

lines 17-42; column 35, lines 13-53; column 59, lines 55-61; column 150, lines 44-52;

and column 154, lines 34-37).

Regarding claim 6 and 20, these claims constitutes a system version of the

claimed method steps above (claim 1). Therefore, for the reasons applied above, such

a claim also is anticipated.

Regarding claims 7-10, these claims constitutes a system version of the

claimed method steps above (claims 3-5). Therefore, for the reasons applied above,

such claims also are anticipated.

Regarding claim 11, this claim constitutes a computer-system-including-

computer-program version of the claimed method steps above (claim 1). Therefore, for

the reasons applied above, such a claim also is anticipated.

Regarding claims 12, this claims constitutes a computer-program-on-computer-

readable-recording-medium version of the claimed method steps above (claim 1).

Therefore, for the reasons applied above, such claims also are anticipated.

Regarding claim 13, this claim constitutes a computer-system-including-

computer-program version of the claimed method steps above (claim 1). Therefore, for

the reasons applied above, such a claim also is anticipated.

Regarding claims 14, this claims constitutes a computer-readable-recording-medium version of the claimed method steps above (claim 1). Therefore, for the reasons applied above, such claims also are anticipated.

Regarding claim 15, this claim constitutes a recording medium version of the claimed method steps above (claim 1). Therefore, for the reasons applied above, such a claim also is anticipated.

Regarding claim 17, this claim constitutes a recording medium version of the claimed method steps above (claim 3), wherein all claim limitations have been addressed as set forth above. Therefore, for the reasons applied above, such a claim also is anticipated.

Regarding claim 18, Ginter teaches all the limitations of claim 1, and further teaches that said digital information comprises data and a function for recalling a function of the user terminal (electronic appliance 600) or a function of a device connected to the user terminal (software to record and report content usage, including ROS application, utilizes the resources of the user terminal's operating system; col. 85, lines 60-62; col. 86, lines 58-61; col. 134, lines 19-22).

Regarding claim 19, Ginter teaches all the limitations of claim 1, and further teaches that said user terminal (electronic appliance 600) transmits said contents utilizing history to said information gathering means (clearinghouse) on condition that a number of times of utilizing a same content by a same user (usage count) exceeds a predetermined number (usage limit) (record content usage and report that usage to the clearinghouse; col. 18, lines 1-5; col. 36, lines 10-43; col. 134, lines 19-22; budget and

metering events record content usage count and usage limit; col. 150, line 43-col. 151,

line 31; col. 188, lines 29-38; metering event involved in usage monitoring triggers a

reporting event, which directs the transmission of usage history to the clearinghouse,

based on a condition being met, including the usage count exceeding the usage limit;

col. 58, lines 23-61; col. 150, lines 43-52).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   **Claim 16 is rejected under 35 U.S.C. 103(a)** as being unpatentable over Ginter.

Ginter teaches all the limitations of claim 15, and further teaches that a

transaction history data recording area for recording transaction history data, indicating

that said contents are properly transacted (column 18, lines 6-21; column 33, lines 36-

65; column 35, lines 13-53; column 40, line 62, through column 4, line 3). But Ginter

does not explain that the transaction history recording area is provided at a position

accessible by said user terminal prior to at least said contents recording area.

However, Ginter teaches that the transaction history data recording area and the

contents recording area exist on the same recording medium (column 17, lines 42-48).

Arbitrarily, the former will occur either prior to or succeeding from the latter. Absent a

showing of criticality as to the particular position of the transaction history data recording

area in respect to the contents recording area, one of ordinary skill in the computer art

at the time the invention was made would select the positioning the former prior to the

latter with equal probability to its contravening format; therefore, the claim would have

been obvious.

Response to Amendment

3.   Applicant's arguments filed 25 July 2005 have been fully considered but they are

not persuasive.

Regarding Applicant's argument that Applicant's claimed method provides "a

means for embedding digital information" which is "in sharp contrast to the method of

Ginter" (Remarks, page 14), it is noted that in one embodiment Ginter teaches the

installation of a virtual distribution environment (VDE) on each physical device to which

content is distributed as a prior and separate step to the installation of the contents.

However, Ginter teaches in another embodiment that the VDE is embedded along with

the contents, stating that "VDE 100 containers can also be stored with all required

control structures and content together" (col. 134, line 67-col. 135, line 1), the control

structures including "computer software and/or methods used to manipulate, record,

and/or otherwise control use of said content" (col. 134, lines 19-21) (see also col. 57,

lines 66-67; col. 134, lines 15-28; col. 135, lines 35-58). Moreover, Ginter teaches that

the rights operating system (ROS) of the VDE, which is used to control the use of

content, is constructed by the content creator along with the content (col. 91, lines 26-

42) and operates as an application running on top of the user device's operating system

(so that the application may accompany the content and be installed along with the content as opposed to requiring that the operating system first be modified) (col. 86, lines 58-61). Hence, Ginter teaches that the software used to record and control the use of the content is embedded along with the content itself.

Conclusion

1.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
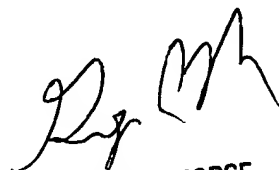
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Elmore whose telephone number is 571-272-4224. The examiner can normally be reached on M 10-8, T-Th 9-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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